

Customer No.: 31561  
Application No.: 10/709,955  
Docket No.: 12257-US-PA

**AMENDMENTS**

**In the Drawings:**

Please amend Figure 1 according to the replacement drawing.

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### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed on February 17, 2006. Reconsideration and allowance of the application are respectfully requested.

#### **Present Status of the Application**

The Office Action objected figure 1 because the Examiner considered that Figure 1 should be designated by a legend such as --Prior Art--. The Office Action rejected claims 1-9, 11, 12, 14-16, 18-23, 25 and 26 under 35 U.S.C. 102(e) as being anticipated by Yano (US 2003/0197931). The Office Action also rejected claims 1-3, 6, 8-10 and 18-24 under 35 U.S.C. 102(e) as being anticipated by Hammond (US 2003/0128426). In addition, the Office Action rejected Claims 13, 17 and 27 under 35 U.S.C. 103(a) as being unpatentable over Yano (US 2003/0197931).

#### **Discussion of Office Action Objections**

The drawings are objected because the Examiner considered that Figure 1 should be designated by a legend such as --Prior Art--. In response thereto, Applicants have amended figure 1 to overcome the objection.

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### Discussion of Office Action Rejections

1. The Office Action rejected claims 1-9, 11, 12, 14-16, 18-23, 25 and 26 under 35 U.S.C. 102(e) as being anticipated by Yano (US 2003/0197931). Additionally, the Office Action rejected claims 1-3, 6, 8-10 and 18-24 under 35 U.S.C. 102(e) as being anticipated by Hammond (US 2003/0128426). Applicants have amended claims 1, 15-17 and cancelled claims 8, 10, 14, 18-27 and respectfully traverse the rejections for at least the reasons set forth below.

Independent claim 1 recites the features as follows:

1. A telescope for observing and/or recording an image, comprising:  
a first monocular, having a first object lens and a first eyepiece;  
a second monocular, having a second object lens and a second eyepiece;  
an image-recording device, disposed between the first monocular and the second monocular; and  
a first optical-switching component, disposed between the first object lens and the first eyepiece for deflecting an incident light beam from the first object lens to the first eyepiece or the image-recording device;  
a second optical-switching component, disposed between the second object lens and the second eyepiece for deflecting an incident light beam from the second object lens to the second eyepiece or the image-recording device; and wherein the image-recording device comprises:  
an image-capturing device;  
a lens assembly, wherein the lens assembly and the image-capturing device are disposed along the optical path behind the first optical-switching component and the first optical-switching component, such that the lens assembly is disposed between the first optical-switching component and the image-capturing device and between the second optical-switching component and the image-capturing device;  
and  
a reflector disposed along the optical path between the first optical-switching component and the image-capturing device and

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between the second optical-switching component and the image-capturing device.

(emphasis added)

Claims 2-7, 9, 11-13 and 15-17 also recite similar features.

In response to the 102 rejection, Applicants have amended claim 1 to more explicitly describe the claimed invention. The reflector recited in claim 1 is not disclosed by Yano (US 2003/0197931). Therefore, claim 1 is not anticipated by Yano (US 2003/0197931).

Additionally, the reflector recited in claim 1 is not disclosed by Hammond (US 2003/0128426). Specifically, Hammond (see paragraph [0038]) only disclosed that "The embodiments in FIGS. 9-11 are similar to those in FIGS. 6-8. However, in FIGS. 9 and 10, the monocular has a second mirror 80. When the first mirror 254 is in the lightpath 50(a), the image is directed to the eye 58. When the first mirror 254 is not in the lightpath (FIG. 10), the light is directed to the image sensor 70". As describe above, Applicants submit that Hammond suggest one skill artisan installing a reflector (second mirror 80) between a first optical-switching component (first mirror 254) and eye 58. However, the optical architecture recited in claim 1 is that a reflector is disposed along the optical path between the first optical-switching component and the image-capturing device and between the second optical-switching

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component and the image-capturing device. Therefore, claim 1 is not anticipated by Hammond (US 2003/0128426) also. The 102 rejection should be withdrawn.

In re paragraph [0032] of US 2003/0197931, Yano disclosed that "when the present invention is applied to a binocular, both telescopes of the binocular can be constructed as shown in FIG. 1. Consequently, the structures of the lens barrels are identical to each other, so that a user can attach the camera to any convenient one of the lens barrels". Obviously, Yano merely disclosed that the camera can be attached to any one of the lens barrels and Yano did "NOT" teach or suggest that the camera can capture the images from both monocular (first monocular and second monocular). Accordingly, Applicants submit that both Yano and Hammond fail to disclose that how to capture the images from both monocular and one skilled artisan would not have motivation to modify the optical architecture disclosed by Yano or Hammond without any teaching or suggestion.

In the telescope as claimed in claim 1, the image capturing device is capable of capturing the images from both the first monocular and the second monocular simultaneously and this function is not disclosed by either Yano (US 2003/0197931) or Hammond (US 2003/0128426). Accordingly, the optical path design of the telescope recited in claim 1 is non-obvious and patentable over the prior art (US 2003/0197931 and US 2003/0197931).

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2. The Office Action rejected Claims 13, 17 and 27 under 35 U.S.C. 103(a) as being unpatentable over Yano (US 2003/0197931). Applicants respectfully traverse the rejections for at least the reasons set forth below.

If independent claim 1 is allowable over the prior art of record, then its dependent claims are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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**CONCLUSION**

For at least the foregoing reasons, it is believed that the pending claims 1-7, 9, 11-13 and 15-17 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Date : *May 3, 2006*

Respectfully submitted,

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